

## **REMARKS**

These remarks are responsive to the Office Action of December 15, 2004. Claims 1, 3-5, 7, 13, 15, 16, 19, 26-28, 32-34, 36, and 38 have been amended. Support for the amendments can be found throughout the specification and especially at pages 15-16 (e.g., paragraph [45]) and at pages 17-18 (e.g., paragraph [48]) and paragraph [51]. No new matter has been added. No claims have been canceled. Claims 1-40 are pending. Applicants request reconsideration and allowance.

## **Examiner Interview**

Applicants wish to thank Examiner Huyen Vo for the courtesies that he and his supervisor extended at the Examiner interview on April 12, 2005. At the interview, Examiner Vo and his supervisor acknowledged that the cited references (U.S. Patent No. 6,683,937, Watson et al. and U.S. Patent No. 5,982,853, Liebermann) failed to explicitly teach or suggest “recording a sign language message” as recited in claim 1. However, despite the lack of this teaching in the prior art, Examiner Vo and his supervisor asserted that the system of either Watson or Lieberman must nevertheless somehow “inherently” store or record an incoming video message. Nevertheless, Examiner Vo and his supervisor further agreed that claim 1 would be allowable over Watson and/or Lieberman if amended to recite that displaying the recorded message is responsive to an input message.

Regarding the Examiner's position on "inherency," it is pointed out that the fact that a certain result or characteristic *may* occur in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981) (holding that "to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient") (emphasis added).

Furthermore, "in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App & Inter. 1990) (emphasis in the original). The Examiner has failed to provide "a basis in fact and/or technical reasoning", objective evidence, or cogent technical reasoning to reasonably support the determination that the system of Watson must necessarily contain a storage for recording the sign language message. Therefore, the inherency rationale fails.

However, in order to expedite prosecution, claim 1 nevertheless has been amended to recite "a video processing unit being operatively coupled to the video server unit, the video processing unit for displaying the recorded sign language message to the

interpreter responsive to receiving a signal” as suggested by the Examiner. Watson fails to teach or suggest “responsive to receiving a signal.”

Examiner Vo and his supervisor further acknowledged that Watson and/or Liebermann fail to teach or suggest a “predetermined profile for the deaf person” as recited in claim 13. However, Examiner Vo suggested that claim 13 be amended to more clearly recite that the predetermined profile for the deaf person is “user-specific”.

Finally, Examiner Vo and his supervisor indicated that claims 7, 19, 28, 34, and 36 would also be allowable over the cited prior art if similarly amended as above.

**Rejection of claims 1, 2, 5, and 6 under 35 U.S.C. 102(e).**

Claims 1, 2, 5 and 6 were rejected under 35 U.S.C. 102(e) over Watson et al. (U.S. Patent No. 6,570,963). This rejection is respectfully traversed.

Claim 1 recites, among other features, a video server unit for receiving and recording a sign language message. Watson discloses that a “calling assistant then relays messages by interpreting sign language via video to the hearing or speech impaired user and talking to the second user” (Watson, Col. 2, lines 49-52). However, Watson fails to teach or suggest recording the sign language message.

The Office Action cites Watson at cols. 5-6 as allegedly disclosing recording the sign language message. However, Watson at cols. 5-6 merely discloses that “[T]he communication assistant then relays messages 208 using sign language to communicate with the hearing or speech and talking to the second party over a voice call.” Col. 6, lines 16-19. It appears Watson’s only reference to recording or storage at all is a “call detail record is stored in memory in the computer system” (col. 6, lines 27-28) or “non-volatile

memory” that “stores instructions needed to perform the basic functions that the processing unit needs for performing more complex functions (col. 6, lines 60-62) or a “volatile memory stores the instructions and data needed by processing unit 302 to perform a function (col. 6, lines 64-66). However, neither the “call detail record”, “non-volatile memory” nor “volatile memory” of Watson records the sign language message. Because Watson fails to teach each and every aspect of claim 1, the rejection should be withdrawn.

As stated above, Applicants believe that the Examiner’s position on inherency regarding claim 1 is improper, however, claim 1 nevertheless has been amended as suggested by the Examiner solely to expedite prosecution. Therefore, claim 1 is allowable.

Claims 2, 5, and 6 depend from claim 1 and are allowable for at least the reasons set forth above. Additionally, claim 5 recites “providing a subscriber profile of the first party.” Watson fails to teach or suggest a subscriber profile. The rejection should be withdrawn.

**Rejection of claims 13-16, 19, 23, 25, 28-29, 31, and 36-38 under 35 U.S.C. 102(b).**

Claims 13-16, 19, 23, 25, 28-29, 31, and 36-38 were rejected under 35 U.S.C. 102(b) as being anticipated by Liebermann (U.S. Patent No. 5,982,853). This rejection is respectfully traversed.

Claim 13 recites, among other features, formatting the real-time sign language input directly into spoken words while relaying. Liebermann discloses receiving “identifiers, and not the images themselves … syntax rebuilding … resulting in a

complete verbal text ... the text then undergoes a text-to-synthesized-speech transformation and the speech is sent ..." Liebermann, col. 5, lines 2-9. Thus, Liebermann discloses converting identifier (not images) to text, then converting the text to speech. Liebermann fails to teach or suggest formatting real-time sign language input directly into spoken words.

At the Examiner interview on April 12, 2005, the Examiner and his supervisor acknowledged that Liebermann converts identifiers to text, then converts text to speech. However, the Examiner and his supervisor asserted that despite the intermediate step of converting to text, Liebermann nevertheless allegedly discloses formatting sign language input "directly" into spoken words. Applicants disagree with the Examiner's assertion.

Further, claim 13 recites, among other features, retrieving a predetermined profile for a first party. Liebermann fails to teach or suggest a predetermined profile for a first party. At the Examiner interview on April 12, 2005, the Examiner and his supervisor acknowledged that Liebermann failed to teach or suggest a predetermined profile that is user-specific. The Examiner and his supervisor stated that claim 13 would be allowable if amended to recite that the predetermined profile for the first party is user-specific. Claim 13 has been amended to recite "retrieving a predetermined user-specific profile for the first party." Therefore, claim 13 is allowable.

Claim 19 is similar to claim 1 and is allowable for at least the reasons set forth above for claim 1. Claim 19, recites, among other features, providing the stored sign language data responsive to receiving a message mode identifier. Liebermann fails to teach or suggest providing the stored sign language data responsive to receiving a

message mode identifier. Therefore, it is respectfully submitted the rejection should be withdrawn.

Claim 28 recites, among other features, a subscriber profile of the first party. Claim 36 recites a predetermined profile for the first party. To expedite prosecution, claims 28 and 36 have been amended as suggested by the Examiner and his supervisor. Claim 28, as amended, recites “a user-specific profile of the first party” and claim 36 recites “a predetermined user-specific profile for the first party”. Therefore, claims 28 and 36 are allowable.

Claims 14-16, 23, 25, 29, 31, 37 and 38 depend from claim 13, 19, 28 or 36 and are allowable for at least the reasons set forth above for claim 13, 19, 28 or 36.

In addition, claims 15 and 37 recite, among other features, “a preselected voice profile”. The Office Action asserts that the “Foreign Language Flag Unit” in FIG. 15 of Liebermann and disclosed at col. 11, lines 52-67 is allegedly equivalent to “synthesized voice corresponding to a preselected voice profile”. However, contrary to the Office Action’s assertion, the “Foreign Language Flag Unit” in FIG. 15 and col. 11, lines 52-67 of Liebermann is unrelated to a “synthesized voice corresponding to a preselected voice profile.” The Office Action provides no rationale as to what the alleged similarities are between the two disparate concepts. The rejection of claims 15 and 37 should be withdrawn.

Also, claims 16 and 38 recite, among other features, generating a synthesized voice identity corresponding to the first party. The Office Action asserts that analyzing the emotional expression of a deaf user is allegedly equivalent to “generating a

synthesized voice identity corresponding to the first party.” However, contrary to the Office Action’s assertion, analyzing the emotional expression of a deaf party is unrelated to “generating a synthesized voice identity.” The Office Action merely alleges the two concepts are equivalent but fails to provide a coherent rationale to support this contention. Indeed, the Office Action fails to provide any explanation at all. Because analyzing the emotional expression of a deaf user is not equivalent to generating a synthesize voice identity, the rejection of claims 16 and 38 should be withdrawn.

Also, claims 25 and 31 further recite, among other features, “an identity code” causing the relay center to “transmit a synthesized voice through the second relay link corresponding to a preselected voice profile.” The Office Action asserts that Liebermann discloses an identity code that causes transmission of a synthesized voice corresponding to a preselected voice profile at col. 6, line 40 – col. 7, line 9.

The “identity code” as recited in claims 25 and 31 causes the relay center to transmit a synthesized voice corresponding to a preselected voice profile. Liebermann fails to teach or suggest such an “identity code”. Liebermann also fails to teach or suggest a preselected voice profile. Moreover, Liebermann fails to teach or suggest a synthesized voice. The Office Action merely asserts that Liebermann provides the teaching but fails to provide a reasonable rationale to support the contention that the different concepts are somehow the same. Therefore, the rejection should be withdrawn.

**Rejection of claims 20-22 and 24 under 35 U.S.C. 103(a).**

Claims 20-22 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Liebermann (U.S. Patent No. 5,982,853). This rejection is respectfully traversed.

Claims 20-22 and 24 depend from claim 19 and are allowable for at least the reasons set forth above for claim 19.

Claims 3 and 4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Watson in view of Brunson (U.S. Patent No. 5,760,823). This rejection is respectfully traversed.

Claim 3, as amended, recites, among other features, transmitting the audio message to the second party based on a user-specific profile corresponding to the second party. Neither Watson nor Brunson, either alone or in combination teach or suggest transmitting the audio message to the second party based on a user-specific profile corresponding to the second party. Watson and Brunson fail to teach or suggest a user-specific profile. Therefore, it is respectfully submitted that the rejection should be withdrawn.

Claim 4, as amended recites, among other features, “transmit the audio message to the second party based on a user-specific profile corresponding to the second party.” Neither Watson nor Brunson, either alone or in combination teach or suggest transmitting “the audio message to the hearing party based on a user-specific profile corresponding to the hearing party. Watson and Brunson fail to teach or suggest a user-specific profile. Therefore, it is respectfully submitted that the rejection should be withdrawn.

**Rejection of claims 7-12, 17, 30, 34, 35 and 39 under 35 U.S.C. 103(a).**

Claims 7-12, 17, 30, 34-35 and 39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Liebermann in view of Brunson. This rejection is respectfully traversed.

Claim 7, as amended, recites, among other features, retrieving a user-specific subscriber profile corresponding to at least one of the calling party and the called party, the user-specific subscriber profile comprising attribute data of the corresponding at least one of the calling party and the called party; and retrieving from storage and relaying the at least one of the sign language message and the audio message to the called party responsive to receiving the message mode identifier based on at least one of said attribute data. Neither Liebermann nor Brunson, either alone or in combination teach or suggest a user-specific subscriber profile or attribute data or retrieving from storage and relaying a message based on at least one of the attribute data. Liebermann and Brunson fail to teach or suggest a user-specific subscriber profile at all. Therefore, it is respectfully submitted that the rejection should be withdrawn.

Claims 8-12 depend from claim 7 and are allowable for at least the reasons set forth above for claim 7.

Claim 17 depends from claim 13. Claim 13, as amended, recites, among other features, a predetermined user-specific profile for the first party in which the predetermined profile includes at least a language preference. Liebermann and Brunson, either alone or in combination, fail to teach or suggest a user-specific profile or a language preference. Therefore, the rejection should be withdrawn.

Claim 30 depends from claim 28. Claim 23, as amended, recites, among other features, a user-specific profile of the first party. Liebermann and Brunson, either alone or in combination, fail to teach or suggest a user-specific profile of the first party. Therefore, the rejection should be withdrawn.

Claim 34, as amended, recites, among other features, retrieving a user-specific profile corresponding to the called party. Liebermann and Brunson, either alone or in combination, fail to teach or suggest retrieving a user-specific profile corresponding to the called party. Therefore, the rejection should be withdrawn.

Claim 35 depends from claim 34 and is allowable for at least the reasons set forth above for claim 34.

Claim 39 depends from claim 36. Claim 36 recites, among other features, a user specific profile for the first party. Liebermann and Brunson, either alone or in combination, fail to teach or suggest a user-specific profile for the first party. Therefore, the rejection should be withdrawn.

**Rejection of claims 18, 26, 27, 32, 33, and 40 under 35 U.S.C. 103(a).**

Claims 18, 26, 27, 32, 33, and 40 were rejected under 35 U.S.C. 103(a) as being unpatentable over Liebermann in view of Ohki (U.S. Patent No. 6,181,778). This rejection is respectfully traversed.

Claim 18 depends from claim 13. Claim 13 recites, among other features, a user-specific profile for the first person. Liebermann and Ohki, either alone or in combination, fail to teach or suggest a user-specific profile for the first person. Ohki merely discloses voice synthesis and not a user-specific profile for the first person. Therefore, the rejection should be withdrawn.

Claim 26 recites, among other features, a predetermined identity code established by the first party so that the audio telephony platform receives the spoken message in a synthesized voice corresponding to a predetermined digital voice profile. The Office

Action admits that Liebermann fails to teach or suggest this recitation but relies on Ohki to make up for the deficits of Liebermann. However, Ohki fails to cure the deficiencies of Liebermann.

Ohki fails to teach or suggest a predetermined digital voice profile or a predetermined identity code established by the first party. Notably, outputting a requested synthesized voice is not the same as a predetermined identity code or a predetermined digital voice profile. Therefore, the rejection should be withdrawn.

Claim 27 depends from claim 26 and is allowable for at least the reasons set forth above for claim 26.

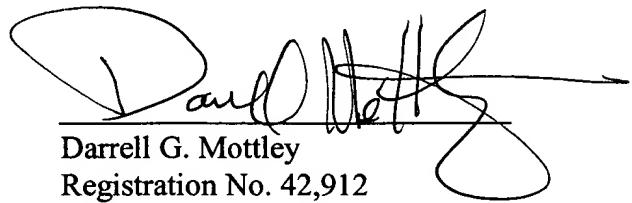
Claims 32 and 33 depend from claim 28. Claim 40 depends from claim 36. Claim 28 recites, among other features, a user-specific profile of the first party. Claim 40 recites, among other features, a user-specific profile for the first party. Liebermann and Ohki, either alone or in combination, fail to teach or suggest a user-specific profile. Therefore, the rejection should be withdrawn.

### **CONCLUSION**

For the foregoing reasons, it is respectfully submitted that this application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in better form for allowance, the Examiner is respectfully urged to contact Applicants' undersigned representative at the below-listed number. If any

additional fees are required or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733.

Respectfully submitted,



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